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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,302	06/20/2003	Matthew David Irving	2003L003	7665

7590 08/02/2005

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EXAMINER

RABAGO, ROBERTO

ART UNIT PAPER NUMBER

1713

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,302

Applicant(s)

IRVING ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Die*

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 5/18/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on US application 10/600,677 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Election/Restrictions***

2. Applicant's arguments filed on 5/18/2005 in traversal of the requirement for election of species is acknowledged. The traversal is on the ground(s) that no claims should be withdrawn as a result of the election of species. This is not found persuasive because a requirement for election of species exists, in cases where a generic claim includes an exceedingly large number of species, to reduce the number of species to a reasonable number for initial examination. In the instant case, the requirement for election of species was made to reduce the number of process reaction steps and components to a reasonable subgeneric group of embodiments. The examined claims were consistent with applicants' initial election, but claims which included a fundamentally new process step (i.e., claims 10, 11 and 14-17) were withdrawn because they were not within the scope of applicants' initially elected scope of processes. Applicants appear to be arguing that an infinite array of additional process steps may be included within an election of species provided a few specific components

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are specified; however, this position is inconsistent with the purpose of requirement of election of species, i.e., to reduce the number of species to a reasonable and defined scope for initial examination. Applicants' implication that withdrawal of any claims is improper in the absence of a restriction requirement is baseless. As stated previously, should the generic claim be found allowable, applicants will be entitled to rejoinder of all of the dependent claims. However, should applicants persist in their traversal of the initial withdrawal of claims 10, 11 and 14-17, and should such argument be accepted, then a new requirement for restriction may be made regarding claims 10, 11 and 14-17. In such case, the non-elected claims would likely not be rejoined if the elected group were found allowable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sivik et al. (US 5,674,819) for the reasons set forth in the Office action mailed 4/18/2005.

Applicant's arguments filed 5/18/2005 have been fully considered but they are not persuasive. Amendment adding the phrase "consisting essentially of" does not distinguish over the reference for the following reasons. Applicants have provided no argument or basis to believe that the exemplified combinations of a minor amount of Trilene and a major amount of polyisobutylene is not within the scope of "polyalkene having a number average molecular weight (Mn) of from about 300 to about 5000, and a terminal vinylidene content of at least 30%" as claimed. On this basis alone,

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applicants' amendment and accompanying argument is ineffective to overcome the rejection. Furthermore, the limitation "consisting essentially of" does not exclude the presence of additional polyalkene other than those "having a number average molecular weight (Mn) of from about 300 to about 5000, and a terminal vinylidene content of at least 30%" because this exclusion has not been clearly stated in the specification or claims as filed as being a basic and novel characteristic of the invention. MPEP

2111.03 states in part:

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

The features which applicants appear to be stressing as improvements over the prior art are those which result in reduced sediment, tar and residual halogen. The specification appears to be devoid of any indication that the absence of a minor amount of another polymer is a basic or novel characteristic in the claimed process. Accordingly, the meaning of "consisting essentially of" as directed to the polyalkene component is deemed to be equivalent to "comprising."

4. Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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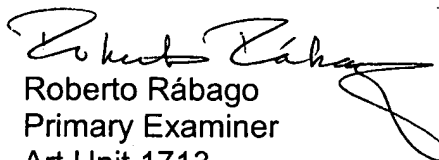
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR  
July 30, 2005